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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,810	02/17/2000	Kyoko Kawaguchi	32410	• 7331

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EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/505,810

Applicant(s)

KAWAGUCHI ET AL.

Examiner

Alain L. Bashore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8-16-02 and interview.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19,21-30 and 33-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,21-30 and 33-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments of record (interview, paper no. 9) have been considered and a new final office action is hereby issued. The time for response is restarted with the mailing of this office action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 39 is a single means claim, and therefore non-enabling because the "server" does not recite a combination of structural elements in the body of the claim.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3, 47, 67-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, the recitation to "the electronic ticket" lacks antecedent basis.

Claims 47, 67-71 recite a separate class of invention (computer-readable recording medium) or are claiming a product-by-process improperly. These claims are considered improper since they refer back to a different class of invention (method). As an alternative interpretation, if these claims are claiming a product-by-process, these claims are improper for not reciting a further definition of the product and that at the "medium" itself is the product of the process.

Claims 1-19 recite "system" in the preamble, which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 14-19, 21, 23-37, 39-46, 48-53, 68-71, are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al in view of Walker.

Williams et al. discloses an electronic utilization system and method. A terminal outputs a signal for a desired electronic asset (as an instruction or request step). The signal is for instructing transmission of a desired electronic asset. The signal can be for settling a charged bill to a desired electronic asset. A server transmits the desired electronic asset to the terminal or to another predetermined terminal (as an electronic asset transmission step). The server further includes: settlement processing means (and settlement step), issuance means (and issuance step) that issue a certificate, processing means (and certificate transmission step) which transmits the certificate issued by the issuance means to the terminal. The terminal is a portable mobile terminal. The terminal displays the message or content of the certificate. An expiration date is also utilized for the certificate.

With respect to the claimed recitation that the terminal generates a sound, it would be obvious to one with ordinary skill in the art to include to Williams et al sound generation for user attention purposes.

The term asset is understood to be defined as anything of value.

Williams et al. does not explicitly disclose:

the certificate is an exchange certificate which comprises settlement information and status information.

issuing an electronic asset, wherein the certificate is exchanged for the electronic asset;

requesting booking of a desired electronic asset.

Walker et al. discloses exchange certificate (conditional offer) comprising settlement information and status information, issuing an electronic asset (guaranteed purchase offer), and requesting booking of a desired electronic asset (confirmation).

It would have been obvious to one with ordinary skill in the art to include booking of a desired electronic asset to Williams et al because Walker et al. and Williams et al teach electronic asset utilization where Walker describes one type of asset.

It would have been obvious to one with ordinary skill in the art to include an exchange certificate and issuing an electronic asset, wherein the certificate is

exchanged for the electronic asset, all to Williams et al because Williams et al teaches that some assets require intermediary steps for purposes of resale (col 3, lines 7-15) and that verification is required for certain assets (col 3, lines 1-6).

8. Claims 9-13, 22, 32, 38, 47, 54, 72-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al in view of Walker et al as applied to claims 1-8, 14-19, 21, 23-37, 39-46, 48-53, 68-71, and further in view of Hughes.

Williams et al in view of Walker et al does not explicitly use the terminology "past-due date".

Hughes discloses re-transmission of transaction messages (col 9, lines 45-67).

It would have been obvious to one with ordinary skill in the art to include re-transmission after a past-due date to Williams et al in view of Walker et al because Hughes teaches misinterpretation and misunderstandings in transaction information between parties (col 2, lines 1-43).

### ***Conclusion***

9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:30 am to 5:00 pm (Alternate Fridays Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1113.

  
Alain L. Bashore  
April 18, 2003

  
**HANI M. KAZIMI**  
**PRIMARY EXAMINER**